

REMARKS/ARGUMENTS

Initially, Applicant would like to express his appreciation to the Examiner for the detailed Official Action provided. Applicant also notes with appreciation Examiner's acknowledgment of Applicant's First Supplemental Information Disclosure Statement filed on May 5, 2004 by the return of the initialed and signed PTO-1449 form and the Examiner's acknowledgment of Applicant's claim for priority and receipt of the certified copies of the priority documents in the Official Action. However, Applicant notes that the PTO-1449 form submitted with Information Disclosure Statement filed on February 11, 2004 has not been initialed and returned by the Examiner. Applicant thus respectfully requests that the Examiner initial and return the PTO-1449 form submitted on February 11, 2004, in the next communication to Applicant. Applicant further gratefully acknowledges the Examiner's allowance of claims 13-17, and indication of the allowability of claims 3-6, 9 and 10.

Upon entry of the present paper, the title will have been amended, claim 1 will have been amended to clarify the claim language therein, and claims 18-29 will have been added, with claims 1-29 remaining pending for consideration by the Examiner. Specifically, Applicant has broadened claim 1 to recite that the optical element moves along the optical axis.

Applicant notes that newly-added claims 18-29 generally respectively correspond to original claims 1-12, and further recite a digital camera having, *inter alia*, a body. In view of the above, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections of all the claims pending in the present application. Such action is respectfully requested and is now believed to be appropriate.

The Examiner has objected to the Title as not being descriptive. In compliance with the Examiner's request, a new title has been provided. Applicant thus respectfully requests that the Examiner withdraw the objection to the Title.

Turning to the merits of the action, the Examiner has rejected claims 1, 2, 7, 8, 11 and 12 under 35 U.S.C. § 102(a) as being anticipated by U.S. Patent Publication US 2002/0135900 to NOMURA et al. (commonly-assigned to Applicant's Assignee), finding that this reference teaches all limitations of these claims.

Applicant respectfully traverses the Examiner's rejection. Applicant submits that NOMURA, as well as the other references of record, are markedly different from the present claimed invention. Specifically, and as discussed above, NOMURA fails to teach or suggest at least the claimed feature of "at least one rotational projection located on said outer peripheral surface of said rotatable ring, wherein said at least one rotational projection is engaged in said at least one circumferential groove such that said rotatable ring is rotatable at an axial fixed position without moving along said optical axis when said rotatable ring is moved to one of said front and rear limits by said advancing/retracting mechanism." Rather, in NOMURA (and as discussed during the Interview), none of the rotatable rings have a rotational projection that engages a circumferential groove such that the rotatable rings are rotatable at an axial fixed position (*i.e.*, the threaded configuration of the rotatable rings of NOMURA allow the rings to rotate while moving along the optical axis). It is therefore respectfully submitted that NOMURA, as well as the other references of record, fails to teach or suggest the invention of independent claim 1 (or of newly-added independent claim 18), as well as the claims dependent therefrom.

With respect to the Examiner's rejection of dependent claims 2, 7, 8, 11 and 12, since these claims are dependent from allowable independent claim 1, which is allowable for at least the reasons discussed *supra*, these dependent claims are also allowable for at least these reasons. Further, all dependent claims (including newly-added dependent claims 19-29) recite additional features which further define the present invention over the references of record. It is thus respectfully submitted that all rejected claims are patentably distinct from the references of record.

Absent a disclosure in a single reference of each and every element recited in a claim, a prima facie case of anticipation cannot be made under 35 U.S.C. § 102. Since the applied reference fails to disclose each and every element recited in independent claim 1, and the claims dependent therefrom, these claims are not anticipated thereby. Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 102(a).

Thus, Applicant respectfully submits that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. §102, and respectfully requests the Examiner to indicate the allowance of each and every pending claim in the present application.

COMMENTS ON STATEMENT OF REASONS FOR THE INDICATION OF ALLOWABLE
SUBJECT MATTER

In response to the Statement of Reasons for the Indication of Allowable Subject Matter, mailed by the Patent and Trademark Office on September 17, 2004, along with the above-noted Office Action, Applicant wishes to clarify the record with respect to the basis for patentability of the allowed claims in the present application. In this regard, while Applicant does not disagree with the Examiner's indications that certain identified features are not disclosed by the prior art references, as noted by the Examiner, Applicant further wishes to clarify that each of the independent claims in the present application recites a particular combination of features, and the basis for patentability of each of these claims is further based on the particular totality of the features recited therein. The dependent claims set forth additional basis for their patentability in accordance with their recited limitations as well as in accordance with the particular limitations of the respective base claims.

SUMMARY AND CONCLUSION


In view of the foregoing, it is submitted that the present paper is in proper form and that none of the references either taken together or taken alone in any proper combination thereof, anticipates or renders obvious Applicant's invention. Accordingly, consideration of the present Response, reconsideration of the outstanding Official Action and allowance of the present application and all of the claims therein are respectfully requested and are now believed to be appropriate.

With respect to Applicant's amendment of claim 1, Applicant submits that this Amendment has not been made for a purpose related to patentability, but rather is a broadening and clarifying amendment that is cosmetic in nature that is not intended to narrow the scope of the claims. Accordingly, this amendment should not be considered a decision by Applicant to narrow the claims in any way.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

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